

**REMARKS**

Claims 21-34 are pending in this application. Claims 21, 28 and 34 have been amended. Claims 24, 25, 26, 27, 30, 31, 32 and 33 have been canceled. No new matter has been added and reconsideration of the application is respectfully requested.

**Claim Rejections Under 35 U.S.C. Section 102**

In the March 16, 2006 Office Action, the Examiner rejects claims 21-23, 25, 27-29, 31, 33 and 34 under 35 U.S.C. §102(b) as being clearly anticipated by Fuerst (U.S. Patent 5,465,509). More specifically, the Examiner states that Fuerst discloses a shoe with a heel protector with eyelets.

Under 35 U.S.C. § 102(b), “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” (MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Accordingly, Fuerst must disclose each and every element of the claimed invention. Fuerst however, does not disclose a shoe having a heel protector wherein the heel protector has at least one horizontal ridge integrally formed in the middle portion and wherein the bottom edge of the protector is stitched to a welt in the shoe, as claimed in amended independent claims 21, 28 and 34 and their corresponding dependent claims. Accordingly, Fuerst does not disclose each and every element of the claimed invention as required under 35 USC 102(b), therefore the applicant respectfully requests withdrawal of this rejection.

Claim 21 stands rejected under 35 U.S.C. §102(b) as being anticipated by Pasternak (U.S. Patent 4,670,998). More specifically, the Examiner states that Pasternak discloses a shoe with a protector that has side portions as claimed in the present application.

As stated above, under 35 U.S.C. § 102(b), “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” (MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Accordingly, Pasternak must disclose each and every element of the claimed invention. Pasternak however, does not disclose a shoe having a heel protector wherein the heel protector

has at least one horizontal ridge integrally formed in the middle portion and wherein the bottom edge of the protector is stitched to a welt in the shoe, as claimed in amended independent claim 21. Accordingly, Pasternak does not disclose each and every element of the claimed invention as required under 35 USC 102(b), therefore the applicant respectfully requests withdrawal of this rejection.

### **Claim Rejections Under 35 U.S.C. Section 103**

To establish a *prima facie* case of obviousness under 35 USC 103(a), three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. (MPEP 2142).

Claims 22, 23, 28, 29, 30 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fuerst in view of Crowley. More specifically, the Examiner states that Fuerst discloses a shoe having a heel protector and Crowley discloses shoe apertures at the end of the sides of the heel protector with eyelets in a shell. Neither Fuerst nor Crowley, alone or in combination, disclose or suggest a shoe having a heel protector wherein, the heel protector has at least one horizontal ridge integrally formed in the middle portion and wherein the bottom edge of the protector is stitched to a welt in the shoe, as claimed in amended independent claim 21 and its dependent claims 22 and 23 or as in amended independent claim 28 and its dependent claims 29 and 30. Therefore, claims 22, 23, 28, 29 and 30, as amended, are not unpatentable under 35 USC 103(a) and this rejection should be withdrawn. Claim 33 has been canceled, therefore this rejection is moot.

Claims 24 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fuerst or Fuerst as modified in view of either Bradley or Gazzano. Claims 24 and 30 have been canceled, therefore this rejection is moot.

Claims 25, 26, 31 and 32 stand rejected under 35 USC 103 (a) as being unpatentable over Fuerst or Fuerst in view of Belyea. Claims 25, 26, 31 and 32 have been canceled, therefore this rejection is moot.

**Conclusion**

Applicant respectfully asserts that all claims are now in condition for allowance, and a Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned at the telephone number appearing below should the Examiner have any questions regarding the prosecution of this application.

Respectfully submitted,

/Lisa M Gehrke/

Lisa M. Gehrke  
Registration No. 38,888

Dated: June 16, 2006

Atty. Docket No. 920.001

Gehrke & Associates, S.C.  
123 North 86<sup>th</sup> Street  
Wauwatosa, WI 53226  
t 414.774.0874  
f 414.774.4837